

REMARKS

This paper responds to the Office Action dated April 21, 2004. In the event that the Examiner finds that a fee is required to complete this response, or if a refund is warranted, he is authorized to appropriately credit or debit our Deposit Account No. 22-0261.

The Rejections Under 35 U.S.C. § 112.

The Examiner rejected claims 1, 3-7 and 9-13 under Section 112 of the patent Statute. Specifically, the Examiner has observed that the text of the specification does not refer to the dimension of the patch with respect to the dimension of the depth of the annular recess formed around the periphery of the through hole formed by the rebate blade of the hole saw. This distance is the same as the distance the rebate blades extend from the flange member. While the applicant agrees that there is no discussion of this relationship in the text of the patent specification, it is submitted that there is adequate disclosure in the drawings, and in particular, Figs. 8 and 9. Figs 8 and 9 show patches having an axial dimension that is less than the depth or axial dimension of the recess that has been formed through the surface for the structure to be opened and then patched. This is illustrated by the space in the drawing between the floor of the annular recess and the patch.

It is submitted that the language cited by the examiner –that the “patch closely conforms to the dimension of the hole” is not inconsistent with the limitation. The description “closely conforms” should be read in conjunction with the drawings and, in particular, Figs 8 and 9. Further, it is submitted that the term “closely conforms” is a

relative term and does not preclude the claimed structure. In fact, the use of the term “closely conforms” in the specification suggests that the patch does not *exactly* conform with the dimension of the recess and therefore contemplates that the patch may have a smaller axial dimension.

Likewise, the description in the specification that the “top surface of the patch is within the same plane as the exterior surface of the gypsum board” is not inconsistent with the claim language, the drawing or disclosure. In particular, Figs 8 and 9 depict patches according to the claimed invention that are located in the same plane as the gypsum board. This relationship is the intended end result after the patch has been inserted within the annular recess formed by the hole saw. In summary, the size of the patch is slightly smaller than the size of the hole formed which allows the patch to fit within the hole. One skilled in the art would understand that spackling compound or adhesive would slightly elevate the patch to allow it to be flush with the gypsum board surface. The specification discusses the use of adhesive or joint compound at page 8.

While the applicant submits that the claimed relationship has adequate support in the specification, as discussed herein, the applicant does not rely upon this relationship for patentability.

The Examiner also rejected claims 8 and 16 under Section 112 in view of a misspelling and an improper lack of antecedent basis, respectfully. The applicant has rectified the absence of the proper antecedent basis in claim 12 and cancelled claim 8 by the present amendment. It is therefore submitted that the Section 112 rejections have been traversed.

The Rejections under 35 U.S.C. §102

The examiner has rejected claims 1, 3-13 under 35 U.S.C. §102 in view of the UK '198 reference. The applicant agrees that the Examiner's rejections of the previously presented claims based upon the new references are adequately grounded. In view of the rejections and the new prior art cited in the case, the applicant has amended claim 1 to incorporate the limitations directed to the rebate blade in claim 15. Claim 15 was previously found to be allowable. Now each of the remaining pending claims requires a rebate blade with an "L shaped" profile. The prior art that discloses a number of devices to result in an annular recess around a through hole however nothing teaches or suggests using an "L shaped" rebate blade structure. For these reasons, it is submitted that the present amendment traverses the rejections of claims 1, 3-7, and 1-13.

Claims 3-7 depend on claim 1 and therefore for the reasons set forth above and in view of the additional limitations are allowable.

Claim 8, a method claim, has been cancelled.

Claims 9-13 are method claims that employ the apparatus recited in claims 1 are novel and not obvious for the reasons that claims 1 is patentable.

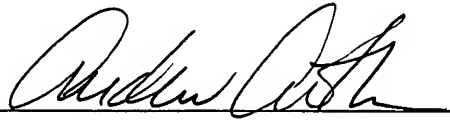
Conclusion

Wherefore, it is submitted that all of the remaining claims are now in condition for allowance and a notice to that effect is respectfully requested. In the event that this response does not resolve all of the outstanding issues, applicant's attorney would be

pleased to discuss any outstanding matter by telephone to try and move the application to allowance.

Respectfully submitted,

Date: July 21, 2004

A handwritten signature in black ink, appearing to read 'Andrew C. Aitken', written over a horizontal line.

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